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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/539,057

06/15/2005

Thomas Hasskerl

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09/25/2008

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

09/25/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 10/539,057 | Applicant(s) HASSKERL ET AL. | |
| | Examiner D. S. Nakarani | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 and 12-24 of copending Application No. 10/538,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application claims a plastic article which inhibits water droplet formation comprising identical substrate, an intermediate layer and an identical inorganic coating. The present invention require intermediate layer formed from a mixture comprising solvent with a specified volatility index, anionic flow control agent and nonionic flow control agent while the invention of U. S. Patent Application 10/538,887 requires intermediate layer formed from a mixture comprising two polymers having specified water contact angels. The invention as claimed in the present application is an open language inclusive of unspecified components. The solvent is not present in the final product. The U.S. Patent Application 10/538,887 suggests use of solvent and conventional flow control agents at page 20. Therefore it would have been obvious to a person of ordinary skill in the art to optimize flow property of the coating composition by using a mixture of flow control agents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krautter et al (U. S. Patent 4,576,864) in view Faverolle et al (U. S. Patent 6,503,631 B1) for the reasons of record set forth in paragraph 5 of the Office Action mailed March 19, 2008 (Paper Number 20080308).

4. Applicant's arguments filed June 18, 2008 have been fully considered but they are not persuasive. In reference to rejection of claims 1-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/538,887, applicants essentially argue that claims of copending application 10/538,887 do not recite the product-by-process limitation of the present claims and further require a certain water contact angle. Further applicants state that the Example 1 and comparative Example 2 demonstrate the criticality of the product-by-process limitation recited in the present claims.

These arguments are unpersuasive because the co-pending application 10/538,887 makes product by same process using butyl acetate as solvent. There is no showing that the process of the co-pending application 10/538,887 is deferent than the process of present disclosure. Also there is no showing that butyl acetate solvent used in the Example 1 of the co-pending application 10/538,887 is deferent than the butyl acetate solvent used in the Example 1 of the instant disclosure.

In reference to rejection of claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Krautter et al (U. S. Patent 4,576,864) in view Faverolle et al (U. S.

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Patent 6,503,631 B1), applicants mainly argue that Faverolle et al and Krautter et al do not disclose a requirement for any intermediate layer applied as a mixture with a solvent having a volatility index of less than 20. Further applicants points to paragraphs bridging pages 1 and 2 of EP-A-0149182 to distinguish certain formable plastic articles of present application from articles disclosed in Krautter et al. In addition applicants state that new dependent claims 23 and 24 recite particular solvents that must be used in the claimed formable plastic article. Krautter et al disclose applying a solution of aqueous silicic material to a substrate. The aqueous silicic material of the examples of Krautter et al cannot render the present claims obvious because water has a volatility index greater than 20, i.e. water is much less volatile than 1-methoxy-2-propanol. Applicants points to the Example 1 and the comparative Example 1 of the present invention to show unexpected results.

These arguments are unpersuasive because the rejection is not based on document EP-A-0149182. The Examiner is unable to find stated paragraph in Krautter et al (U. S. Patent 4,576,864). Krautter et al form an intermediate layer using polymer solution in a mixture of isopropyl alcohol and toluene. The top coat is formed using argued solution of silicic material. In Example 1 of the present disclosure the top coat also formed with an aqueous based composition. There is no showing that Krautter et al's solvent mixture of isopropyl alcohol and toluene has volatility index higher than 20. Furthermore there is no showing that Krautter et al's article is different than the article of the present invention.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/D. S. Nakarani/
D. S. Nakarani
Primary Examiner, Art Unit 1794**

DSN
September 16, 2008.